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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,690	03/07/2001	Li-Lung Chao	YOR920010128US1/I27-0007	5054

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EXAMINER

FADOK, MARK A.

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/800,690

Applicant(s)

CHAO ET AL.

Examiner

Mark Fadok

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Objections***

Claim 3 is objected to because of the following informalities: in line 4 of the instant claims the word "form" should be "from". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 USC 101 because these claims have no connection to the technological arts (i.e. computer, network, data processing, internet, ect.). In this case even though the database could be construed as an electronic database it still does not define any actionable processing and is therefore considered

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to be a trivial use of technology. To overcome this rejection, the examiner recommends that the applicant amend the claims to incorporate limitations directed to the technological arts in the body of the claims. Please note that merely reciting technological limitations in the preamble of the claim is not sufficient to overcome this rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alnwick (US 2002/0007318) in view of Official Notice.**

**In regards to claim 1**, Alnwick discloses a system for back ordering out of stock products, the system comprising:

a host system for receiving an order for a product from a user (FIG 1),  
determining whether inventory for said product satisfies said order (abstract, particular component in stock?),

notifying said user if said inventory for said product does not satisfy said order  
(page 4, line 56),

Alnwick teaches searching for a product and determining if available quantities are in stock (para 56), placing an order for a back ordered quantity that was not available from the current stock (para 76), updating inventory amounts (para 76), having a vendor approve the order (para 86) and tracking status (para 86), but does not specifically mention that the inventory is updated after the back ordered product is received and that the customer is notified. It was old and well known in the art at the time of the invention to update inventories when product is received and notify a customer when a back ordered product is available for pick up or delivery. It would have been obvious to a person having ordinary skill in the art to include in Alnwick notifying the customer of an updated inventory that reflects that the order quantity is available, because this would provide the customer additional information which would improve the customer's scheduling.

receiving a delivery request from said user to deliver said product (page 6, para 78);

a network coupled to said host system (page 6, para 86); and

a database coupled to said host system for storing data relating to said back ordering out of stock products (page 7, para 94).

**In regards to claim 2**, Alnwick teaches a user system coupled to said network (FIG 1, item 3); and

said user system accessing said host system via said network (FIG 1).

**In regards to claim 3**, Alnwick teaches wherein said acquiring said amount and updating said inventory includes said host system:

requesting said amount from a supplier; and

receiving a request from said supplier to add said amount to said inventory (see response to claim 1).

**In regards to claim 4**, Alnwick teaches placing a time limit on an active quote in which after that time the quote expires (para 93) and placing a back order (see response to claims 1-3), but does not specifically mention that a time period is placed by the user on the back ordered items from a supplier. It was old and well known at the time of the invention to place specific requirements on delivery requests. It would have been obvious to a person having ordinary skill in the art to include in Alnwick having the capability to allow the customer to cancel an order if the product was not available on a certain date, because this would free both the customer and the supplier from the contract and allow the customer to pursue other suppliers to attain potentially critical parts.

**In regards to claim 5**, Alnwick teaches notifying said user that said back order request will remain on hold for a predetermined time (para 93);

determining whether said predetermined time has expired; and

deleting said back order request if said predetermined time has expired (see response to claim 4 above).

**In regards to claim 6**, Alnwick teaches wherein said delivery request includes said host system:

    sending a back order confirmation request to said user;  
    receiving a back order confirmation; and  
    reducing said inventory data to reflect said back order confirmation (see response to claims 1-5 above).

**In regards to claims 7 through 21**, these claims and their features are considered parallel claims to claims 1-7 and are rejected to the same reasons as claims 1-7 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner